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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,865	02/25/2002	Kunio Fukuda		1375

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EXAMINER	
SHAH, CHIRAG G	
ART UNIT	**PAPER NUMBER**
2616	

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,865	FUKUDA, KUNIO	
	Examiner	Art Unit	
	Chirag G. Shah	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *preliminary amendment 4/15/02*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 7-10* is/are rejected.

7)☒ Claim(s) *5,6,11 and 12* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3 and 8-10 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 8-9 of U.S. Patent No. 6,930,987. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skills in the art that the present invention (09/980865) above claims are broader than the claims of U.S. Patent No. 6,930,987.

The comparison of the two applications:

Claims 1 and 3; 8 and 10 of the present application are similar to claims 1 and 8 respectively of Patent No. 6,930,987 except the main differences is that claims 1 and 8 of the Patent No. 6,930,987 provides a name for the first radiocommunication means as wired communication means and the second radiocommunication means as short distance radio

communication means. Therefore, it would have been obvious to one skilled in the art that since based on the comparison of the respective claims, the claim language is phrased differently claiming the same subject mater, thus they are not patentably distinct from each other.

Claims 2 and 9 of the present application is similar to claim 2 and 9 respectively of Patent No. 6,930,987 expect the communication network is replaced by external communications network. Therefore, it would have been obvious to one skilled in the art that since based on the comparison of the respective claims, the claim language is phrased differently claiming the same subject mater, thus they are not patentably distinct from each other.

3. Claims 1-4 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,3, 4, and 2 respectively of copending Application No. 09/980867. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skills in the art that the present invention (09/980865) above claims are broader than the claims of Application No. 09/980867.

The comparison of the two applications:

Claims 1 of the present application are similar to claim 1 respectively of Application No. 09/980067 except the main differences is that claim 1 of the Application No. 09/980067 provides a name for the second radiocommunication means as external communication means.

Claim 2 of the present application is identical to claim 3 respectively of Application No. 09/980067.

Claim 3 of the present application is identical to claim 4 respectively of Application No. 09/980067.

Claim 4 of the present application is identical to claim 2 respectively of Application No. 09/980067.

Therefore, it would have been obvious to one skilled in the art that since based on the comparison of the respective claims, the claim language is phrased differently claiming the same subject mater, thus they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2, 4, 7-8, and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (U.S. Patent No. 6,272,120) in view of McKinley et al. (U.S. Patent No. 5,805,834), hereinafter McKinley.

Regarding claims 1 and 7, Alexander discloses in **figs. 1 and 3** of a communication apparatus **[multi-radio bridge 100, see figs. 1 and 3] and method**, comprising:

first radiocommunication means **[multi-radio bridges includes two or more radio devices, the first radiocommunication means is one of the two or more radio devices, see col. 5, lines 8-12 and fig. 3]** for sending data to a host device **[host device 132, fig. 1]** and receiving data from the host device **[host device 132, fig. 1]** via a radio communication network **[via wired backbone network 130, fig. 1]**;

second radiocommunication means **[multi-radio bridges includes two or more radio devices, the second radiocommunication means is second of the two or more radio devices, see col. 5, lines 8-12 and fig. 3]** for sending data to a communication device **[one of Bridge A or Bridge B or Bridge C, see fig. 1]** and receiving data from the communication device connected to an external communication network **[via wireless radio network operating in DS or FH system, see col. 5, lines 23-50 and fig. 1]** separate from the radiocommunication network via the radiocommunication network **[via wired backbone network 130, fig. 1]**;

storage means **[memory 286, fig. 3 and col. 8, lines 20-41]** for storing communication setting information on the external communication network **[memory stores program code and information such as where devices are registered from the external communication network with mobile devices, see col. 8, lines 20-41]**; and

Alexander discloses in **col. 5, lines 23-49** of the multi-radio bridge 100 having a central processor for controlling the first radiocommunication means **[first radio of two or more radios, see col. 5, lines 23-49]** and the second radiocommunication means **[second radio of two**

or more radios, see col. 5, lines 23-49] to transfer data between the external communication network **[external LAN networks, fig. 1]** and the host device **[host device 132, fig. 1]**.

Alexander fails to explicitly disclose communication controlling means for setting a relation of connection to the external communication network via the radiocommunication network and the communication device based on the communication setting information stored in the storage means.

McKinley discloses in figure 1 and 2A, column 3, lines 12-45 and respective portions of the specification of a PCMCIA (radio) card 118 that may be used with a computer or a mobile device for a variety of functions. Included within the peripheral function card 118 of figure 1 are a memory card 122a, which may be configured to communicate with a host device such as a computer, two I/O controller chips 122b, 122c, adaptor chip, and EEPROM. Furthermore, McKinley discloses in claims 1 and 2 and in column 7,lines 38 to column 8, lines 43 that the PCMCIA card has memory storage for storing configuration programming information as information related to communication network. McKinley further discloses in figure 1 and in column 5, lines 21 to column 6, lines 34 of controller chips, which enables communication with a remote computer system. Therefore, it would have been obvious to one of ordinary skills in the art to modify the teachings of Alexander to include explicit functions, the storage and control means of a radio card as disclosed by McKinley. One is motivated as such in order for using the configuration programming information read form the memory storage device to configure the bridging circuit to bridge a communication path between the internal bus system and one of the plurality of other bus systems.

Regarding claims 2 and 8, Alexander discloses in col. 8, lines 20-42 of the multi-radio bridge apparatus, wherein the information storage means [memory 286] stores personal information of a user that operates the host device [e.g. mobile terminals and hosts]. Alexander, however fail to disclose the communication controlling means uses the communication setting information stored in the storage means and the personal information stored in the storage means to set a relation of connection between the host device and the external communication network.

McKinley discloses wherein the individual information is stored in the storage means as information related to a user operating the host equipment, and wherein the communication control means sets the connection between the host equipment and the communication setting information and the individual information stored in the storage means [see in figure 1 and in column 7, lines 38 to column 8, lines 43, where RAM stores address ranges, pin configurations, and status flags related to user operating the host equipment, the new configuration programming loaded into the EEPROM is then used to reconfigure the adaptor circuit to bridge a communication path]. Therefore, it would have been obvious to one of ordinary skills in the art to modify the teachings of Alexander to include explicit functions, the storage and control means of a radio card as disclosed by McKinley. One is motivated as such in order for using the configuration programming information read form the memory storage device to configure the bridging circuit to bridge a communication path between the internal bus system and one of the plurality of other bus systems.

Regarding claims 4 and 10, Alexander discloses in figs. 1 and 3 of the apparatus [multi-radio bridge 100, see figs. 1 and 3], wherein the second radiocommunication means [multi-radio

bridges includes two or more radio devices, the second radiocommunication means is second of the two or more radio devices, see col. 5, lines 8-12 and fig. 3] connects via the radiocommunication network [via wireless network, see fig. 1] to a mobile communication device [mobile terminal 172, fig. 1] having a protocol [DS or FH protocol] for connecting to a mobile network; and

the communication controlling means [central processor for the multi-bridge radio 100, see col. 5, liens 23-43] sets a relation of connection between the mobile network [wireless network having mobile terminal 172, fig. 1] and the host device [Host 132, fig. 1] via the radiocommunication network [see fig. 1] as claim.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 3 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander in view of McKinley as applied to claims 1-2, 4, 7-8, and 10 above, and further in view of Hind (U.S. Patent No. 6,772,331).

Regarding claim 3, Alexander in view of McKinley fails to explicitly disclose the apparatus, wherein the storage means stores one of PPP (point to point protocol), IP (Internet protocol), and TCP (transport control protocol); and the communication controlling means uses one of the protocols stored in the storage means to set a connection between the host device and

the external communication network and to control the data transfer between the host device and the external communication network.

Hind discloses teaches column 1, lines 18-22 of a short-range network for securely transmitting information among wireless devices. Hind disclose a method and a device (radio within every mobile device as disclosed in column 1, lines 38-54, figure 3) comprising: wired communication means for providing/receiving data via physical connection means to/from a mounted host equipment [as disclosed in column 1, lines 38-54 and column 2, lines 10-23 and in figure 3, where a Blue tooth radio is attached to every mobile device]; short distance radio communication means for transmitting/receiving data to/from an external communication network via a short distance radio communication network [as discloses in column 2, lines 10-23 and figure 3, where an access point or wireless device with a Bluetooth radio can attach a picocell to an enterprise LAN or WAN]. **Hind discloses in column 7, lines 46-67 and column 2, lines 11-23 of the radio module using TCP/IP, the radio module has a memory and discriminates by using TCP/IP for transmission between host and enterprise WAN. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to modify the teachings of Alexander in view of McKinley to include incorporating transmission between host and external networking using TCP/IP in order to provide connections over interconnected networks.**

Allowable Subject Matter

8. Claims 5-6 and 11-12 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

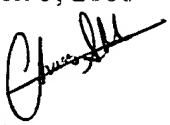
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag G. Shah whose telephone number is 571-272-3144. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on 571-272-7682. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cgs
April 5, 2006



Chirag Shah
Patent Examiner, Division 2616